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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/531,534 | 04/15/2005 | Jiro Kiyama | 63281 (70904) | 1423 |
| 21874 | 7590 | 07/24/2008 | EXAMINER | |
| EDWARDS ANGELL PALMER & DODGE LLP | | | WENDMAGEGN, GIRUMSEW | |
| P.O. BOX 55874 | | | ART UNIT | PAPER NUMBER |
| BOSTON, MA 02205 | | | 2621 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/531,534 | KIYAMA ET AL. | |
| | Examiner | Art Unit | |
| | GIRUMSEW WENDMAGEGN | 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 April 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4 and 6-14 is/are rejected.
 7) Claim(s) 5 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/18/08;3/20/07;2/6/07;9/19/06;7/12/05;4/15/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim11-14 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim11, a data recording medium for storing AV data as recited in claim11 is non-statutory subject matter.

Claim 12 and 13 is drawn to a “program” *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a.

Regarding claim14, a recording medium for storing a program as recited in claim14 is non-statutory subject matter.

Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus

statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim1-4, 6-14 is rejected under 35 U.S.C. 102(e) as being anticipated by Sugahara et al (Pub No US 2003/0103766).

Regarding claim1,4,8,9, 11-14, Sugahara et al (hereinafter Sugahara) anticipates a method for recording, onto a recording medium, (i) AV data obtained by multiplexing a plurality of sets of stream data in accordance with a predetermined multiplexing rule, and (ii) associated data to be reproduced in synchronism with the AV data, the method comprising: a first step of dividing the AV data into partial AV data and of dividing the

associated data into partial associated data, in accordance with a predetermined interval (see paragraph 0075 and figure7 102a); a second step of securing, in the recording medium, a first continuous region for continuously storing a series of the partial AV data and the partial associated data; a third step of continuously recording the partial AV data and the partial associated data onto the first continuous region (see paragraph 0080); and a fourth step of recording, onto the recording medium, file system management information for (i) managing the partial AV data and the partial associated data as different files, and (ii) managing information for handling the partial AV data and the partial associated data as the different files(see paragraph 0098 and figure8).

Regarding claim2, the method as set forth in claim1, further comprising: a fifth step of recording, onto the recording medium, (i) reproduction start time of the partial AV data, and (ii) correspondence information of the partial AV data and the partial associated data, both of which are disposed in the first continuous region (see paragraph 0075-0076).

Regarding claim3,7, the method as set forth in claim 1, further comprising: a sixth step of recording, onto the recording medium, information indicating whether or not the partial associated data is recorded adjacent to the corresponding partial AV data (see paragraph0102- 0103 , address).

Regarding claim6, the method as set forth in claim 4, further comprising: an eighth step of recording, onto the recording medium, (i) reproduction start time of the partial AV data, and (ii) correspondence information of the partial AV data and the partial associated data, both of which are disposed in the first continuous region (see paragraph 0093-0094).

Regarding claim10, the AV data recording apparatus as set forth in claim 9, further comprising: means for dividing, during the recording of the associated data, the associated data into partial associated data in accordance with a predetermined interval (see figure7 102a) ; means for recording, during the recording Of the associated data, the partial associated data onto the region secured by the partial reservation data which is stored in continuity with the partial AV data corresponding to the associated data (see figure 7 107-108); means for recording, onto the recording medium during the recording of the associated data, file system management information for (i) managing the partial associated data as a different file from the respective files of the partial AV data and the partial reservation data, (ii) managing information for handling the partial associated data as a different file (see figure 7 107-108 ; paragraph 0098).

Allowable Subject Matter

Claim5 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIRUMSEW WENDMAGEGN whose telephone number is (571)270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alr Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Girumsew Wendmagegn/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621

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